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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/665,821  | 09/22/2003  | Valerie De Poilly    | 230016US0           | 7262             |
| 22850   | 7590        | 12/30/2005           | EXAMINER            |                  |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      | SINGH, JAI P        |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1616                |                  |

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/665,821 | <b>Applicant(s)</b><br>DE POILLY, VALERIE |  |
|                              | <b>Examiner</b><br>Jai P. Singh      | <b>Art Unit</b><br>1616                   |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 9/22/2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

Claims 1-27 are pending.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16 and 19-21, drawn to a composition comprising water, at least one metal salt of phosphorylated ascorbic acid and UV screening agent of formula (I) comprising at least one sulphonic function and at least one maleic anhydride polymer, classified in class 424, subclass 401, 78.02, 78.2
- II. Claims 1-14, 17, 19-21 drawn to a composition comprising water, at least one metal salt of phosphorylated ascorbic acid and UV screening agent of formula (II) comprising at least one sulphonic function and atleast one maleic anhydride polymer classified in class 424, subclass 59, 78.03.
- III. Claims 1-14, 18, and 19-21, drawn to a composition comprising water, at least one metal salt of phosphorylated ascorbic acid and UV screening agent of formula (III) comprising at least one sulphonic function and at least one maleic anhydride polymer, classified in class 424, subclass 60, 665.

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- IV. Claims 1, 22 and 24-26 drawn to a method of depigmenting and/or bleaching the skin, preventing and/or combating skin marks, wrinkles and/ fine lines on the skin, for preventing and/or combating the signs of aging of the skins and/or for combating the harmful effects of UV radiation, classified in class 424, subclass 78.06, 665; class 514 and subclass 844.
- V. Claims 1, 23 and 24-26, drawn to method of treating age marks by applying the composition of claim 1 to skin, classified in class 424, subclass 681; class 514 and subclass 828.
- VI. Claims 27, drawn to a method for preparing a uniform aqueous composition comprising metal salt of phosphorylated ascorbic acid, water soluble UV-screening agent containing one sulphonic function and maleic anhydride polymer, classified in class 424, subclass 665; class 514, subclass 947.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the ascorbic acid have been found useful in many applications. Ascorbic acid (vitamin C) stimulates collagen synthesis which is essential to maintain healthy skin. Ascorbic acid (an anti-oxidant) also used for

protection of skin against exposure to sunlight by neutralizing reactive oxygen species (free radicals). Other derivatives of ascorbic acid such as ascorbyl palmitate, magnesium ascorbyl phosphate has been used in place of ascorbic acid (vitamin C).

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II-VI, restriction for examination purposes as indicated is proper. The UV-screening agent in group II and III have different structures and the search for each structures with different substituents will be an additional burden for the examiner.

These inventions are distinct and have acquired a separate status in the art because of their recognized divergent subject matter, different classes and subclasses. Due to divergent subject matter and different classification the search for the application of ascorbic acid derivatives in combination of each UV-screening agent will be an undue burden for the examiner. Additionally, the use for ascorbic acid derivatives as an anti-oxidant and search for this divergent subject matter and its application will place an additional undue burden for the examiner. Therefore the restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: The application contains several metal salts of phosphorylated ascorbic acid (claim 11), different comonomer units (claim 4). In addition to this the benzylidenecamphor derivatives of formula (I), (II) and (III) also have several species with the definition of the substituents on each formula.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for search purposes, even though the requirement is traversed. The election of species must contain one single species of metal salt of phosphorylated ascorbic acid (claim 11) and one comonomer (claim 4). If any formula selected in group I, II and III for the examination, then the formula must contain a single substituent defining the structure of the formula for search purposes. This must also contain single species of metal salts of phosphorylated ascorbic acid and a comonomer with group selected.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise

include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply

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where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

A telephone call was made to Mr. Richard Treanor on December 2, 2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

#### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jai P. Singh whose telephone number is 571-272-8147. The examiner can normally be reached on M-F from 8:30AM to 5:00 PM.

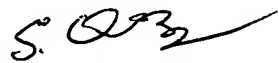
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan (acting) can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jps  
12/13/2005

  
SABIHA QAZI, PH.D  
PRIMARY EXAMINER